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United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Taylor

Mailed: March 6, 2006

Opposition No. 91163169

Chemical Financial Corp.

v.

200 Kelsey Associates, LLC

Before Rogers, Walsh and Zervas,  
Administrative Trademark Judges.

By the Board:

200 Kelsey Associates, LLC ("applicant") seeks to register the mark CHEMICAL BANK for "banking services; financial services, namely, financial analysis and consultation, financial services in the field of money lending, money lending, investment fund transfer and transaction services."<sup>1</sup>

Chemical Financial Corp. ("opposer") has opposed registration on the grounds of priority of use and likelihood of confusion. Specifically, opposer alleges that it and/or its subsidiary companies have been in the banking business since 1917; that opposer and its subsidiaries have been using various names and marks containing the term "Chemical" for banking and financial services since 1917 and the name and mark CHEMICAL BANK for over 40 years; that opposer is the owner of an

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<sup>1</sup> Application Serial No. 76567833, filed December 31, 2003, and alleging a bona fide intent to use the mark in commerce. The term "Bank" has been disclaimed.

application for the mark CHEMICAL BANK<sup>2</sup>; that there is no issue as to priority because the date of applicant's intent to use application is subsequent to opposer's first use of the CHEMICAL BANK mark and name and its other names and marks using the term "Chemical"; that applicant's mark is identical to opposer's mark and applicant seeks to register its mark for most of the same services in connection with which opposer uses its mark; and therefore, applicant's CHEMICAL BANK mark so resembles opposer's previously used CHEMICAL BANK mark, and related marks and names, as to be likely, when applied to applicant's services, to cause confusion, mistake or deception and be a source of damage to opposer.

Applicant, in its answer, has denied the essential allegations of the notice of opposition. Applicant has also pleaded the affirmative defenses of waiver, estoppel and acquiescence.

This case now comes up for consideration of opposer's motion for summary judgment on the issues of priority of use and likelihood of confusion. In support of its motion, opposer argues that there are no genuine issues of material fact and that it is entitled to summary judgment as a matter of law. More specifically, opposer argues that it has decades of prior use resulting in undisputed priority; that applicant has

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<sup>2</sup> Application Serial No. 78522836, filed November 24, 2004 for the mark CHEMICAL BANK for "banking services; financial services, namely investment management and advice and investment fund transfer and transaction services; trust services, namely investment and trust company services; and insurance agency services" and reciting October 6, 1964 as the date of first use and the date of first use of the mark in commerce. The term "Bank" has been disclaimed.

admitted that it has made no use of the mark, at least as of April 21, 2005; that the parties use their marks, in part, on identical services; and that the respective marks are identical.

As evidentiary support for its motion, opposer has submitted the declaration of its president and CEO, David B. Ramaker. Mr. Ramaker states, in relevant part that:

3. In 1962, the name of Chemical State Savings Bank was changed to "Chemical Bank and Trust" and that company began to use simply the service mark CHEMICAL BANK.
4. ... Opposer and its subsidiaries now have customers in all 50 states and, since 2000, they have had over \$3 billion in assets.
5. Opposer and its subsidiaries offer a full array of banking services as well as financial services including investment management and advice and investment fund transfer and transaction services. ... Opposer and its subsidiaries have been using various names and marks containing the dominant word "Chemical" for these banking and financial services since 1917, including using the name and mark CHEMICAL BANK for over 40 years.
6. Opposer and its subsidiaries have continuously used their CHEMICAL BANK mark from its adoption with the name change from 1962 to the present.

Mr. Ramaker also attests to the history of opposer and opposer's and opposer's subsidiaries' use of names and marks including the term "Chemical" since 1917. Mr. Ramaker introduces related exhibits, including: (1) a copy of an advertisement that appeared in the *Midland Daily News* newspaper in 1962 announcing the Chemical State Savings Bank change of name to Chemical Bank and Trust Company, including the slogan "Just say 'Chemical Bank'" (Exhibit C to the Ramaker Declaration); (2) a copy of an article that appeared in the *Bay*

*City Times* newspaper on April 13, 1967 with the headline "Chemical Bank Plans Building" (Exhibit D to the Ramaker Declaration); (3) a copy of an article from the *Midland Daily News* newspaper that appeared on March 15, 1967 with the headline "Coin display at two Chemical Bank offices" (Exhibit E to the Ramaker Declaration); (4) a copy of an advertisement for "Chemical Bank" from the Alma Reminder publication that appeared on March 31. [sic] 1971 (Exhibit F to the Ramaker Declaration); (5) a copy of an advertisement for "Chemical Bank" that appeared in the *Midland Daily News* on September 8, 1971; (Exhibit G to the Ramaker Declaration); (6) copies of advertisements in which it or its subsidiaries used the Chemical Bank mark appearing in various publications from 1995 through 2000 (Exhibit H to the Ramaker Declaration); and (7) copies of advertising material featuring the CHEMICAL BANK mark used by opposer in 2005 (Exhibit I to the Ramaker Declaration). Opposer has also submitted applicant's responses and objections to opposer's first set of admissions showing that applicant has admitted no use of its CHEMICAL BANK mark as of April 21, 2005.

Applicant has opposed the motion arguing that summary judgment is not appropriate in this case because genuine issues of material fact exist with respect to several *DuPont*<sup>3</sup> factors, i.e., the similarity of the marks, the scope of protection to be afforded the pleaded marks, the strength of the pleaded marks and the sophistication of the purchasers. More specifically, applicant argues that opposer has introduced

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<sup>3</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 177 USPQ 563 (CCPA 1973).

scant evidence of the CHEMICAL BANK mark standing alone; that opposer has used the marks CHEMICAL BANK AND TRUST COMPANY, CHEMICAL BANK SHORELINE and CHEMICAL BANK WEST, among other names, for its commercial banking operation within the state of Michigan and, thus, the proper comparison of the parties' marks should include a comparison of all of the various iterations used by opposer over the years. Applicant further argues that the record does not support opposer's assertion that its mark is strong and well established because (1) opposer has never operated a bank under the exact mark "Chemical Bank" and opposer has presented only scant evidence of advertisements depicting the exact mark; (2) while opposer claims to have customers in all fifty states, the record indicates that opposer's banks are located exclusively in the state of Michigan and that this regional presence militates against a finding that opposer's marks are famous or strong; and (3) opposer has not stated how much it spends annually to market, advertise and promote its banking operations.

Applicant also argues that for more than 100 years a third-party, Chemical Banking Corporation, used the name CHEMICAL BANK in connection with banking and financial services and that opposer co-existed with CHEMICAL BANKING CORPORATION until 1996, i.e., when the third-party use of CHEMICAL BANK ceased. Applicant additionally argues that because the customers of each party's banking and financial services are likely to be highly sophisticated, they are likely to

appreciate and understand the difference between opposer's and applicant's banking operations.

Applicant has supported its position with the declaration of one of its attorneys, Edmund J. Ferdinand III, introducing: (1) a copy of opposer's 2003 Annual Report to Shareholders showing no use in the report of the exact CHEMICAL BANK mark; (2) a copy of advertising produced by opposer showing opposer's use of its full name, i.e., Chemical Bank and Trust Company; (3) copies of pages from JP Morgan Chase showing opposer's company size; (4) copies of Internet web cites showing prior use of the Chemical Bank mark by a third party; (5) printouts from the United States Patent and Trademark Office's TESS data base of dead third-party registrations for the mark, CHEMICAL BANK; and (6) copies of an exchange of correspondence between the now defunct Chemical Bank and opposer primarily to show that in 1988 opposer did not operate outside of the state of Michigan.

In reply, opposer contends that applicant has pointed to no facts in dispute and did not dispute any evidence. Particularly, opposer argues that applicant did not dispute the sworn declaration testimony of opposer's President and CEO, David Ramaker, that opposer has used the CHEMICAL BANK mark for over 40 years; and that applicant failed to explain why opposer does not have rights in the mark CHEMICAL BANK simply because opposer may also have rights in three variations of the mark.

Opposer also argues that its mark is not weak because the dominant portion of the mark is "Chemical," a term that is

arbitrary when applied to banking and financial services. As regards applicant's assertion of third-party use of the Chemical Bank mark, opposer argues that an abandoned mark does not constitute significant third-party use, and that such former third-party use is irrelevant to this proceeding. Opposer further argues that even if the concurrent use of the CHEMICAL BANK mark by opposer and a single third party weakened opposer's CHEMICAL BANK mark, opposer's CHEMICAL BANK mark is entitled to protection.

As regards the sophistication of the customers, opposer argues that the average banking customer is not so highly sophisticated to distinguish between the parties' asserted marks. For these reasons, opposer maintains that it is entitled to summary judgment.

As has often been stated, the purpose of summary judgment is one of judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). The burden in a motion for summary judgment is on the moving party to establish prima facie that there is no genuine issue of material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); and *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986).

Turning first to the issue of priority of use, applicant states in footnote 1 of its brief in opposition to the motion for summary judgment, "[f]or purposes of this motion only, Applicant will not challenge opposer's claim to priority of rights over the CHEMICAL mark." Accordingly, priority of use is not in issue.<sup>4</sup>

Turning to the issue of likelihood of confusion, we find that there are no genuine issues of material fact relating to the issue of likelihood of confusion. Turning first to the parties' asserted marks, applicant's applied for mark is identical to one of opposer's asserted marks, namely, CHEMICAL BANK. Although applicant argues that opposer has never operated a bank under the CHEMICAL BANK mark "standing alone," we find that opposer has offered evidence showing continuous use of the CHEMICAL BANK mark in the promotion of its banking and financial services. (See Paragraphs 3, 5 and 6 of the Ramaker Declaration and Exhibits C, D, E, F, G, H and I to the Ramaker Declaration.) Indeed, applicant questioned neither the veracity nor the authenticity of the Ramaker declaration or the attached exhibits. Instead, applicant takes issue with the quantity of the materials showing use of the CHEMICAL BANK

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<sup>4</sup> Even if priority were at issue, we find that opposer has established, through the Ramaker declaration, use of CHEMICAL BANK as part of its trade name and as a trademark since 1962. The earliest date on which applicant may rely, in the absence of evidence to prove otherwise, is the filing date of its involved intent to use application, i.e., December 31, 2003. See *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991). Moreover, applicant, in its responses to opposer's first request for admissions, admits that as of April 21, 2005, it had made no use of the involved CHEMICAL BANK mark.



mark. The evidentiary sampling submitted by opposer is sufficient to show opposer's use of the CHEMICAL BANK mark "standing alone."

Further, we are not persuaded by applicant's contention that use by opposer and/or its subsidiaries of the marks CHEMICAL BANK AND TRUST COMPANY, CHEMICAL BANK SHORELINE AND CHEMICAL BANK WEST, among other trademarks and names for its commercial banking operations, diminishes the significance of opposer's asserted CHEMICAL BANK mark. Rather, and contrary to applicant's contention, we find that use by opposer of different marks and names containing the term "Chemical Bank" simply reinforces public recognition of the CHEMICAL BANK mark by opposer and its subsidiaries.

Applicant attempts to argue that significant third-party use of the CHEMICAL BANK mark for banking and financial services weakens opposer's asserted mark. We find, however, the admittedly abandoned third-party use unpersuasive in this regard. Moreover, any concurrent use of the CHEMICAL BANK mark by opposer and a single third-party entity conferred no rights upon applicant to concurrent use of the CHEMICAL BANK mark.

As regards the parties' services, it is undisputed that they are identical or closely related and complementary in nature, all being banking and financial services. We therefore find that there is no genuine issue of material fact that the services provided by the parties are the same or sufficiently related that when sold under the involved marks, confusion is likely.

Applicant also argues that banking customers are so sophisticated that they could distinguish between the parties' marks. The determination of whether a likelihood of confusion exists is made by evaluating and balancing the pertinent *du Pont* evidentiary factors. See *In re E. I. du Pont de Nemours, supra*. Not every factor is equally important to the likelihood of confusion analysis in every case. In this case, even if the parties' banking customers were considered sophisticated, the parties' identical marks and virtually identical services are sufficient to satisfy the *DuPont* analysis.

In sum, we find that opposer has carried its burden of proving that no genuine issues of material fact remain as to the issues of priority of use and likelihood of confusion and that opposer is entitled to judgment as a matter of law. In view thereof, opposer's motion for summary judgment is granted. The opposition is sustained and registration by applicant of application Serial No. 76567833 is refused.

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